

II. REMARKS

A. Introduction

In this Office Action, claims 1, 7-10 and 15-23 are noted as pending, claims 7, 15, 16 and 19 are allowed, and claims 8-10, 17, 18 and 20-23 are rejected.

In summary of this Response, claims 1, 15 and 17-19 are amended and remarks are provided. In particular regard to independent rejected claim 1 and allowed independent claims 15 and 19, same have been amended to avoid any inference under SuperGuide Corp. v. Direct TV Enterprises, Inc., 69 U.S.P.Q.2d 1865 (Fed. Cir. 2004) that both recited configurations of the second section must be used together. Also, the antecedent basis has been completed for the spring.

B. Rejection of Claim 1 Under 35 U.S.C. § 102

This claim has been rejected as being anticipated by Niino, of record. In particular regard for the spring, Niino is cited for showing "an elastic member (a rubber 42 with diaphragms 44) arranged between the base part and the operating part...the elastic member further including an opening (hole 43) for receiving the fulcrum." Action, page 3, numbered para. 5. Also, Niino mentions that the elastic member 42 could be a "coil spring, a leaf spring, or the like". Col. 6, lines 36-39.

In light of the following, it is respectfully submitted that the present invention, as recited by amended, independent claim 1, was not anticipated by the cited art. Most particularly at least, the elastic member recited by claim 1 was neither anticipated nor rendered obvious by the cited reference.

Amended claim 1 recites, as an elastic member, a plate spring provided with a first section extending annularly around the fulcrum and fixedly supported on the base part, and a second section which is a plurality of concentric, elongated members, each of which extends arcuately along the first section to exert a spring action, wherein there is an opening formed between the first section and each of the plurality of elongated members.

For support for these amendments, see, e.g., Fig. 1, member 74 (plate spring), 76 (first section), 78 (second section) and the opening (space) formed between the second section and the first section, and page 11, lines 34-37 page 12, lines 1-20, page 14, lines 30-37 and page 15, lines 11-20. See also, e.g., Fig. 6, wherein the second section 78' is again arcuate and takes

therebetween.

In contrast, Niino merely discloses a round rubber elastic member 42, which is solid except for the central opening 43 for receiving the fulcrum. The member 42 includes four "bellows"-like diaphragms 44, inbetween which there are no openings. See Figs. 3 and 4 and Col. 5, lines 22-38 thereof. Even if there were opening formed between the bellows, same would not appear to be able to affect the bias of the bellows.

C. Rejection of Claims 8-10, 17, 18 and 20-23 Under 35 U.S.C. § 112

These claims are rejected under 35 U.S.C. Section 112, first paragraph. The Action takes the position that the written description lacks support for a combination of "in a rotatable manner" and "as the exclusive support for the pointing device".

Initially, independent claims 17 and 18 have been amended to delete the phrase "as an exclusive support for the pointing device", as same is not believed necessary for patentability. That is, each claim is a combination of prior independent claims 8 and 9 and the allowable subject matter of dependent claim 5. See February 20, 2004 Office Action, numbered paragraph 10, and the May 20, 2004 Response, Section G. Accordingly, it is believed that at least claims 17 and 18 fully comply with 35 U.S.C. Section 112, and otherwise are patentable over the art.

For the following reasons it is respectfully submitted that the remaining claims 8-10 and 20-23 fully comply with Section 112. While the Examiner cites to passages (page 20, lines 22-31 and page 21, lines 6-20) describing a structural relationship depicted in FIG. 11B, said relationship is merely one embodiment. A separate embodiment is described in the application, without the need for the additional support.

While the Examiner suggests that the first time the "rotatable" feature is introduced is at page 21, lines 6-20, this is not accurate. As noted in the "Summary of the Invention" section of the application as filed at page 6, lines 11-15, the invention provides "a connector part arranged adjacent to the base part and the operating part, the connector part being detachably connectable to a data processor and serving to support the base part and the operating part when the connector part is connected to the data processor." Page 6, lines 10-15 and 20-23. Thus, the connector part (106) is the support for the pointing device (100). Further, it is stated that "It is advantageous that this pointing device further comprises a housing for accommodating the operating part and the detecting part, the connecting part being rotatably coupled to the housing." Page 6, lines 24-27. Thus, this same supportive connecting part is rotatably coupled to the housing.

These statements, along with others like it discussed below, indicate that, for this embodiment, only the rotatable connector supports the device, contrary to the conclusion stated at page 4, lines 4-6 of the Action.

More particularly, page 17, lines 5-11 confirm that the pointing device 100 includes, among other things, a connector part 106, for detachably mounting the pointing device to the data processor. Again, it is made clear that it is the connector that mounts the pointing device, without any reference to a need for any additional support.

Page 18, line 21 to page 20, line 1 describe, with reference to Figs. "7-10B" (page 17, line 2), and not FIG. 11B showing the additional support 150, the following:

The connector part 106 includes a connector 130 having ...a rectangular connecting section..., a casing 132 for securely accommodating the connector with the connecting section being exposed...The casing is a drum-shaped assembled component having a generally arcuate sectional shape corresponding to the shape of the receptacle 128 ...and is received in the receptacle 128 while the cylindrical outer surface portion of the casing 132 is opposed to or brought into contact with the cylindrical curved surfaces of the recesses 124, 126.

...the ribs 134 of the receptacle 128 in the housings 118, 120 are respectively fitted into the outside grooves 136 of the casing 132. The connector part 106 is thus coupled to the housings 118, 120 in a rotatable manner along the ribs 134 in the receptacle 128, so as not to fall out of the receptacle.

...it is possible to complete both the electrical connection and the mechanical attachment of the pointing device 100 to the data processor 140 by simply connecting the connector part 106 with the interface part 148, and thereby to readily or rapidly perform the attachment/detachment of the pointing device.

(emphasis supplied)

This passage makes clear that the mechanical and electrical connector are complete with just the engaged connector 130 and the received rotatable connector part 106: no separate support is described or needed for this embodiment.

Thus, an embodiment of the present invention is where the pointing device is detachably connected to the data processor in a rotatable manner, via the connector 130, and the connector can provide the sole mechanical and electrical support for the pointing device relative to the data processor, without any separate support, like the member 150 shown in FIG. 11B.

That this interpretation is correct, was within the grasp of the inventors when the application was filed, and is feasible, is further supported by the claims as filed, which are a part of the specification as filed. Independent claim 9 as filed recited in relevant part "a connector part ...being detachably connectable to a data processor and serving to support said base part

and said operating part when said connector part is connected to the data processor". There was no limitation concerning any separate support member 150. Claim 10, depending from claim 9, recited the rotatable nature of the connector part. Finally, claim 11, depending from claim 10, recited "wherein said housing includes an engaging section engageable with a housing body of the data processor.

Thus, consistent with the doctrine of claim differentiation, the claims as filed distinguished between a connector embodiment (claim 9), a rotatable connector embodiment (claim 10) and a rotatable connector embodiment that included an engaging section, separate from the connector, for engaging a housing of the pointing device with the data processor (claim 11). These claims 9-11 were not rejected under 35 U.S.C. Section 112, first paragraph in the first Office Action, i.e., the May 28, 2002 Office Action, or in the February 20, 2004 Office Action. On the contrary, as noted in numbered paragraph 4 of the February 20, 2004 Action, Claims 9-11 were apparently quite clear and amply supported when the specific recitations thereof were relied upon in a rejection under Section 102.

Thus, the specification, as discussed above, describes an embodiment wherein a rotatable portion of the pointing device is mounted on a data processor to both mechanically and electrically support, without any further structural element, the pointing device relative to the data processor. In contrast to the unsupported conclusion at page 4, lines 11-12 of the Office Action, the specification does fairly suggest, and actually expressly teaches, that the connector part should be supportive in a "rotatable manner", regardless of the use of any separate support.

The above description is totally devoid of any reference to the alternate embodiment shown in Fig. 11B, which is not described until later in the specification, i.e., at page 20, lines 22-31, i.e., a support section 150 which "may be provided" on the housing body of the data processor. This language clearly indicates an optional nature of this structure, as the above-described discussion shows that this member was not necessary for rotatably supporting the pointing device using the connector only.

Then, after discussing the embodiment described above, the written description discusses an alternate embodiment, wherein a movable "support section" 150 could be on the data processor, and an "engaging section" 138 could be on the pointing device to cooperate therewith. When the pointing device is attached to the data processor, and when the support section 150 is used, the pointing device can be rotated as shown in Fig. 11B to clear the support section 150 and engage this section 150 via the engaging section 138. Page 21, lines 6-20. If no support section 150 is used, however, there is no need for this optional engagement.

Finally, the Examiner's comment that a rotatable pointing device is "hardly feasible" is merely speculation as to how the pointing device would be used, and is without evidentiary support as to what one of ordinary skill would consider upon reviewing the specification.

As these claims do find support in the application as filed, the arguments included in the last Response about the cited art is expressly incorporated herein. In this regard, it is respectfully submitted that the next Action should not be a final Action, since the present Action raised the Section 112 issue discussed above, without citing any art against the subject claims.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 1, 7-10 and 15-23 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

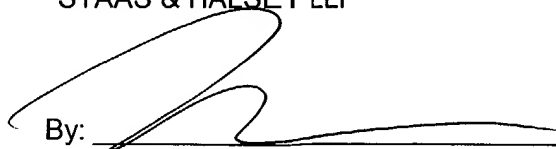
Respectfully submitted,

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